

REMARKS

I. Introduction

This paper addresses the non-final Office Action of February 4, 2009, in connection with the above-captioned application. Claims 1-93 are currently pending. Claims 19-68 were previously withdrawn from consideration. Claims 1-18 and 69-93 have been rejected. Claims 94-99 are added. The new claims are fully supported by the application as originally filed. No new matter has been added. In view of the foregoing amendment and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

II. Rejection of Claims 1-6, 10-15, 69, and 84-93 under 35 U.S.C. § 103(a)

Claims 1-6, 10-15, 69, and 84-93 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,471,039 (“Irwin”), in view of U.S. Patent No. 6,758,403 (“Keys”). The present claims are patentable over the proposed combination of Irwin and Keys for at least the following reasons.

Some example embodiments of the present invention provide for a platform-independent execution environment for executing embedded instructions, where the instructions may be embedded in a barcode. Such barcodes may include instructions and/or data that may be processed by a virtual machine. Notably, in these example embodiments of the present invention, executable program instructions themselves, including complex flow of control using conditional instructions, may be encoded in the barcodes.

For example, in some example embodiments of the present invention, an embedded barcode may include instructions for processing a game selection slip. In such an example, a user may wish to play a pick-six game and an embedded barcode on a game selection slip may include instructions so that the terminal can verify that the selection slip was completed correctly by the user. For example, the terminal may read the barcode and determine that the slip is for a pick six game. The terminal may process the instructions embedded in the barcode included on the slip and verify that all six numbers, in this example, were selected properly. Notably, in these example embodiments, such terminals may not need to be re-programmed to process a new type of game. For example, if a new game such as a pick five or pick seven game is introduced, gaming terminals would not need to be programmed to process gaming slips for the new game. Rather, barcodes on the new slips may simply include instructions that will instruct the terminal how to process the selection slip for the new game. For example, the instructions may inform the terminal to generate a pick five or

pick seven game, to verify that the numbers were properly selected, and/or or to perform other checks related to processing the selection slip and generating a ticket. In accordance with example embodiments of the present invention then, programming of terminals to process new types of games may be avoided and savings of costs and/or other resources may be realized.

More particularly, independent claim 1 recites:

A method for validating a ticket associated with a game of chance,
comprising:

reading, at a terminal, **a barcode encoded with data and a first program comprising a plurality of instructions, the plurality of instructions including a conditional instruction**, wherein the barcode is included on the ticket;

based on the encoded first program and **responsive to execution of the conditional instruction**, sending the data and a trigger to execute a check validity program to validate the data; and

responsive to a determination of the data being valid by the check validity program, validating the ticket.

First, it is respectfully submitted that the proposed combination of references does not teach or suggest all of the features of claim 1. For example, claim 1 recites “reading, at a terminal, a barcode encoded with data and a first program comprising a plurality of instructions, the plurality of instructions including a conditional instruction, wherein the barcode is included on the ticket,” “based on the encoded first program and responsive to execution of the conditional instruction, sending the data and a trigger to execute a check validity program to validate the data.” Thus, claim 1 recites a barcode **on a ticket** that contains **both data and a program**, and also recites that sending the data and a trigger to validate the ticket responsive to execution of that program. By the use of such barcodes, the some example systems according to claim 1 are able to eliminate the need to update and reconfigure terminals when new types of tickets are introduced. Because both data and a program are included on the ticket itself, a terminal may validate a ticket simply by reading the data and executing the program included on that ticket.

The proposed combination of references does not teach or suggest such features.

Irwin generally describes a ticket with a validation code. The Office Action admits that Irwin does not teach or suggest all the elements of Applicant’s claim1, stating:

Irwin fails to teach a bar code encoded with data and a first program comprising a plurality of instructions, the plurality of instructions including a conditional instruction, and sending the data based on the encoded first

program. Irwin fails to teach reading a first program comprising a plurality of instructions, and executing the program, wherein executing the program includes sending the trigger.

[Office Action at 3.]

The Office Action asserts that Keys describes the elements which are admittedly missing from Irwin, asserting:

Keys shows an instructional bar code 310 (Fig. 3i). Keys discloses that the set of instructions to configured the program 90 within the control circuit 40 is communicated to the control circuit 40 by means of an instructional bar code 310 or a set of such bar codes (col 49, lines 14-18). As shown in Fig. 2B, the instructions includes a conditional instruction, such as “IF,” and also shows a “SEND” function for sending a trigger.

[Office Action at 3-4.]

Keys, however, does not teach or suggest such a barcode. Rather, at most Keys may generally describe using a barcode **to cause the installation of** a program in a device. Keys barcodes encode at most a single instruction, if at all. Even if Keys bar code arguably included an instruction, Keys does not teach or suggest “reading, at a terminal, **a barcode encoded with data and a first program** comprising a plurality of instructions, the plurality of instructions including a conditional instruction, **wherein the barcode is included on the ticket.**” As explained above, the barcode of claim 1, including both data and a program, is included on a ticket itself. In that way, the ticket including such a barcode may be validated by an existing terminal without requiring reconfiguration of the terminal for each new ticket type. In contrast Keys does not teach or suggest such a feature. In fact, it would appear that Keys requires exactly the kind of reconfiguration that is eliminated by the invention of claim 1. In order to process information on a new kind of barcode, the device in Keys must have a new program installed. Keys, col. 49, l. 14-25. Thus, in Keys new programs are developed, delivered, and installed on the device in order to handle new data formats. Notably, Keys describes special “instructional” barcodes used to cause the installation of new programs, but there is not teaching or suggestion that the bar codes themselves encode the programs.

Keys describes exactly the sort of system that the example embodiments of claim 1 are designed to avoid – Keys requires his reader to be reprogrammed to handle new data formats and or operating procedures. Keys' instructional bar code merely cause a new program to be loaded. The invention of claim 1 eliminates the need for similar reconfiguration. By encoding instructions and data for validating a ticket in the bar code **on**

the ticket itself, the method of claim 1 makes it possible to simply scan and validate a new ticket without more, even if the validating terminal has never processed or programmed to handle such a ticket before. Accordingly, it is respectfully submitted that Keys does not teach or suggest the elements of claim 1 not taught by Irwin, and that, therefore, the proposed combination of references does not teach or suggest each of the elements of claim 1.

In addition, even if the cited references were to teach each of the elements of claim 1, which they do not, the Office Action still fails to make out a *prima facie* case of obviousness. Specifically, the Office Action has failed to provide any reasoning which supports the rejection. The Supreme Court has explained that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR v. Teleflex*, 550 U.S. 398, 82 USPQ2d at 1396. Examiners must provide “fact based evidence” for prior art rejections. *Ex Parte Whalen II*, Appeal 2007-4423, July 23, 2008

The present Office Action, however, presents no such reasoning and no such fact based evidence, presenting only a conclusory statement that the subject matter of claim 1 would have been obvious over the cited references. Specifically, the Office Action says only that

it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Keys to the teachings of Irwin in order to quickly instigate an actions of verification without the need to go through complicated systems by directly providing instruction on the barcode that leads to the validation program.

[Office Action at 4.]

The Office Action does not provide any other reasoning or facts to support its conclusion of obviousness. The reasoning presented, however, is nothing more than a conclusory statement that the subject matter of claim 1 would have been obvious in light of the cited references. The reasoning does not suggest how the teachings of Irwin and Keys might be combined in any detail. And, in fact, the Office Action’s proposed reasoning does not even appear to be accurate. The Office Action proposes that it would have been obvious to combine the teachings of Irwin and Keys in order to achieve a simpler validation system. However, the systems of both Irwin and Keys are highly complicated. Irwin, for example, appears to rely on a combination of barcodes and conductive material and circuitry embedded in items to be validated to achieve its purpose. It is simply unclear how any combination of the references could lead to a simpler system, let alone the particular system of Applicant’s claim 1.

That the Office Action has failed to provide the “articulated reasoning” required to carry its burden of presenting a *prima facie* case of obviousness is illustrated by the fact that the reasoning presented was used verbatim in the previous Office Action to support a rejection over a different combination of references. Office Action of Feb. 25, 2008 at 4. Clearly the Office cannot present meet its burden of providing “articulated reasoning” by presenting a single conclusory statement not tied to the actual references under consideration. As the Federal Circuit has recently noted “We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.” *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008).

For at least the reasons present above, it is respectfully submitted that the Office Action does not present a *prima facie* case of obviousness as to claim 1, and, indeed, that claim 1 and its dependent claims, including claims 2-6, 84-88, and 91, are patentable over the references.

Separately and independently, with respect to claims 84-88 to 91, the Office Action has failed to identify any of the claimed features in the cited references. Neither the cited references, nor their proposed combination teach “choosing a network server” based on an encoded program read from a ticket as recited in claim 84, “choosing a network address” based on the program, as recited in claim 86, sending the data and the trigger as part of “executing the program” as recited in claim 88. These claims should therefore be allowable for at least these additional reasons.

Independent claims 10, and 69 recite elements similar to those discussed above in connection with claim 1. Accordingly, it is also respectfully submitted that claims 10, 69, and their dependent claims, including claims 11-15, 89, 90, 92, and 93, are also patentable over the cited references for at least reasons similar to those presented above in connection with claim 1. In addition, claims 89 and 90 should be allowable for reasons similar to those discussed above for claim 88.

Therefore, withdrawal of the rejections over Irwin and Keys is respectfully requested.

III. Rejection of Claims 74, 78, and 82 under 35 U.S.C. § 103(a)

Claims 74, 78, and 82 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Irwin and Keys, in view of U.S. Patent No. 4,825,058 (“Poland”). Claims 74, 78, and 82 are patentable over the proposed combination of Irwin, Keys, and Poland for at least the reasons presented below.

Claim 74 depends from claim 1, claim 78 depends from claim 10, and claim 82 depends from claim 69. As explained above, the proposed combination of Irwin and Keys does not teach or suggest each of the elements of independent claims 1, 10, and 69, as presented. The Office Action does not suggest that Poland teaches or suggests the elements of claims 1, 10, or 69 not taught or suggested by Irwin and Keys, and it is respectfully submitted that Poland does not teach or suggest those elements. Accordingly, it is respectfully submitted that independent claims 1, 10, and 69 are patentable over the proposed combination of Irwin, Keys, and Poland, as are dependent claims 74, 78, and 82.

Also, the proposed combination of Irwin, Keys, and Poland is improper for reasons similar to those presented in Applicant's previous response. The Office Action posits that Poland would be combined with Keys and Irwin "in order to ensure that the instructions provided by the bar code can be properly executed, which avoids any erroneous operation." However regarding the reading of a barcode encoded with a program comprising a plurality of instructions, the Poland reference only discusses reading a single instruction at a time. That is, the Poland reference never reads a plurality of instructions of a program from a single barcode. Instead, the Poland reference either reads a single instruction in a single barcode, or else actually requires reading multiple barcodes to obtain only a single instruction. See, for example, Poland col. 6, l. 60 - col. 7, l. 63, and col. 8, l. 48 - col. 9, l. 54, which in part reads as follows (emphasis added below):

... there are three different types of commands. The first type is a single scan command that includes a memory manipulation opcode, an address and an argument to complete a configuration selection. The second type of command requires two scans, a memory manipulation opcode with an address, followed by a separate numerical or single character argument to complete a configuration selection. The third type of command requires multiple scans, a memory manipulation opcode with an address, followed by a string of single character arguments from separate tags, and is terminated by scanning an end of characters tag.

Thus, the Poland reference never discloses or suggests reading a barcode encoded with a program comprising a plurality of instructions.

Furthermore, the Poland reference even effectively teaches away from the proposed combination, because Poland teaches away from reading of a plurality of instructions from a single barcode. "A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). For example, at col. 7, l. 64 -

col. 8, l. 34, the Poland reference extols the virtues of its simple command set which “conserves memory space in the operating system and provides efficient operation of the interpreter.” Thus, one of ordinary skill in the art would be discouraged from the idea of encoding a plurality of instructions on a single barcode based on a fair reading of the Poland reference. Since the Poland reference is expressly concerned with reducing the complexity of even a single command read by the barcode reader, one of ordinary skill in the art would surely be dissuaded from attempting to read a plurality of commands at once by such a barcode reader. (The Office is respectfully reminded that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

For at least the reasons present above, it is respectfully submitted that claims 74, 78, and 82 are patentable over the proposed combination of Irwin, Keys, and Poland. Withdrawal of the rejection is respectfully requested.

IV. Rejection of Claim 7 under 35 U.S.C. § 103(a)

Claim 7 was rejected under 35 U.S.C. § 103(a), as being unpatentable over Irwin and Keys, in view of U.S. Patent No. 6,340,331 (“Saunders”). Claim 7 is patentable over the proposed combination of Irwin, Keys, and Saunders for at least the reasons presented below.

Claim 7 depends from claim 1. As explained above, the proposed combination of Irwin and Keys does not teach or suggest each of the elements of independent claim 1, as presented. The Office Action does not suggest that Saunders teaches or suggests the elements of claim 1 not taught or suggested by Irwin and Keys, and it is respectfully submitted that Saunders does not teach or suggest those elements. Accordingly, it is respectfully submitted that independent claim 1 is patentable over the proposed combination of Irwin, Keys, and Saunders, as is dependent claim 7. Withdrawal of the rejection is respectfully requested.

V. Rejection of claims 8, 9, 16, 17, 18, 70 and 71 under 35 U.S.C. § 103(a)

Claims 8, 9, 16, 17, 18, 70 and 71 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Irwin and Keys, in view of U.S. Patent No. 5,337,358 (“Axelrod”). Claims 8, 9, 16, 17, 18, 70 and 71 are patentable over the proposed combination of Irwin, Keys, and Axelrod for at least the reasons presented below.

Claims 8 and 9 depend from claim 1, claims 16-18 depend from claim 10, and claims 70 and 71 depend from claim 69. As explained above, the proposed combination of Irwin and Keys does not teach or suggest each of the elements of independent claims 1, 10, and 69, as presented. The Office Action does not suggest that Axelrod teaches or suggests the elements of claims 1, 10, or 69 not taught or suggested by Irwin and Keys, and it is respectfully submitted that Axelrod does not teach or suggest those elements. Accordingly, it is respectfully submitted that independent claims 1, 10, and 69 are patentable over the proposed combination of Irwin, Keys, and Axelrod, as are dependent claims 8, 9, 16, 17, 18, 70 and 71. Withdrawal of the rejection is respectfully requested.

VI. Rejection of claims 72, 73, 75-77, 79-81, and 83 under 35 U.S.C. § 103(a)

Claims 72, 73, 75-77, 79-81, and 83 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Irwin and Keys, in view of U.S. Patent No. 6,915,271 ("Meyer"). Claims 72, 73, 75-77, 79-81, and 83 are patentable over the proposed combination of Irwin, Keys, and Meyer for at least the reasons presented below.

Claims 72, 73, and 75 depend from claim 1, claims 76, 77, and 79 depend from claim 10, and claims 80, 81, and 83 depend from claim 69. As explained above, the proposed combination of Irwin and Keys does not teach or suggest each of the elements of independent claims 1, 10, and 69, as presented. The Office Action does not suggest that Meyer teaches or suggests the elements of claims 1, 10, or 69 not taught or suggested by Irwin and Keys, and it is respectfully submitted that Meyer does not teach or suggest those elements. Accordingly, it is respectfully submitted that independent claims 1, 10, and 69 are patentable over the proposed combination of Irwin, Keys, and Meyer, as are dependent claims 72, 73, 75-77, 79-81, and 83. Accordingly, for at least the reasons presented above, withdrawal of the rejection is respectfully requested.

VII. New Claims 94-99

Claims 94-99 are added herein. The claims are fully supported by the application as originally filed and no new matter has been added. In addition, it is respectfully submitted that the new claims are patentable over the cited references for at least the following reasons.

First, the new claims depend from claims 1, 10, and 69 and therefore should be allowable for at least the same reasons as their respective parent claims.

Separately and independently, these claims all recite sending data to a location specified by the program encoded on the ticket, or similar features. In claims 95, 97, and 99,

the location is specified as a network address. Neither of these features are taught or suggested by the cited art. The new claims should therefore be allowable for these additional reasons.

CONCLUSION

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited. While no additional fee is considered to be due, the Office is hereby authorized to charge any fees, which may arise out of the filing of this paper, or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to the deposit account of **K&L Gates LLP**, Deposit Account No. **0080570**.

The Examiner is invited to contact the undersigned at the telephone number below to discuss any matter concerning this application.

Respectfully submitted,

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